

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed September 6, 2006. At the time of the Final Office Action, Claims 1, 2, 4-8, 10, 11, 13-15, and 17-22 were pending in this Application. Claims 3, 9, 12, 16 and 23 were previously cancelled without prejudice. Claims 1, 2, 4-8, 10, 11, 13-15, and 17-22 stand rejected.

Claim Rejections under 35 U.S.C. § 103

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of U.S. Patent 6,208,345 issued to Nicolas C. Sheard et al. ("Sheard") and further in view of U.S. Patent 6,954,751 issued to Christfort et al. ("Christfort"). Applicant respectfully disagrees with this rejection.

Claims 2, 4-6, 10, 11, 13-15, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Sheard in view of Christfort as applied to Claim 1 above, and further in view of U.S. Patent 6,549,922 issued to Alok Srivastava et al. ("Srivastava et al."). Applicant respectfully disagrees with this rejection.

Claims 7, 8, 17 and 20 were rejected under 35 U.S.C. § 103(a) as being obvious over Applicant's Admitted Prior Art and Sheard in view of Christfort, as applied to Claim 1 above, and further in view of U.S. Patent 5,878,220 issued to Jeffrey C. Olkin et al. ("Olkin et al.") Applicant respectfully disagrees with this rejection.

Claims 18, 21 and 22 were rejected under 35 U.S.C. § 103(a) as being obvious over Applicant's Admitted Prior Art in view of Sheard and Christfort, as applied to Claim 1 above, and further in view of non-patent document "The Gemini Telescope Control System" by Taylor et al. ("Taylor et al."). Applicant respectfully disagrees with this rejection.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The Examiner stated Christfort teaches a remote Internet client coupled with said runtime system. Applicant respectfully disagrees. Christfort neither discloses nor mentions an automation system including a runtime system and an engineering system. The terms "runtime system" and "engineering system" are well known in the technical field of automation systems. In particular the combination of an engineering system with a runtime system in an automation system is well known and defined. Furthermore these terms are defined in the present application, for example, in paragraphs [0002] and [0003] of the present specification.

Christfort merely discloses an network based operating system for mobile clients. Christfort, in particular, discloses a specific service for an online software development system. See Christfort, abstract. Fig. 1A of Christfort discloses a plurality of application developers 120, 122, and 124 which are coupled with a host server 110. Neither application developers 120, 122, and 124 are runtime systems as defined in the present application.

Moreover, Applicant believes that Christfort is not prior art under 35 U.S.C. § 102/103 because Christfort has a filing date as of September 5, 2001 whereas the present application claims amongst others priority to German Application DE 100 64 400 which has a filing date as of December 21, 2000. An English translation of the respective priority document and a statement that the translation is accurate are enclosed. Therefore, the Examiner cannot rely on Christfort as prior art.

Applicant respectfully submits that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicant respectfully requests reconsideration and allowance of the dependent Claims. Applicant reserves the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of all pending Claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,
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Date: November 6, 2006

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